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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,474	05/15/2001	Yoshimichi Yamanaka	010611	8058

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/14/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,474

Applicant(s)

YAMANAKA, YOSHIMICHI

Examiner

Christopher M. Keehan

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 23-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

Claims 1-12 and 23-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8 to prosecute the invention of Group II, claims 13-22. It should be noted that Applicant elected **Group II, claims 1-12** on the response to the restriction requirement. Stephen Adrian subsequently telephoned the Examiner and clarified that Group II was elected, but **Group II** was incorrectly stated as Claims 1-12, rather than **Claims 13-22**.

Claim Objections

Claim 13 is objected to because of the following informalities: Applicant states in the preamble "a cured product" but in the body of the claim Applicant states "a curable composition". It is not clear how the product can be cured when there are no process steps of curing.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-22 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. "A saturated hydrocarbon" is critical or essential to the

practice of the invention, but is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). "A saturated hydrocarbon polymer containing at least one alkenyl group per molecule" as stated by Applicant in the Specification, is not clear. If the polymer contains at least one alkenyl group per molecule, i.e. unsaturation, then it is not clear how the polymer can be saturated.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 13, Applicant states "A saturated hydrocarbon polymer having at least one alkenyl group per molecule." It is not clear how a polymer having at least one alkenyl group per molecule can be a saturated polymer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 13, ²²~~14 and 18-22~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over et al. (4,788,254) in view of Azechi (5,942,583). Regarding Claims 13-15 and 18-22, Kawakubo et al. disclose a bonding method for bonding a curable product to a substrate of a curable composition comprising a saturated hydrocarbon polymer having at least one alkenyl group per molecule, more specifically polyisobutylene, polyisoprene, and polybutadiene (col.3, line 1-col.4, line 33) onto a primed surface, thereby forming a laminate obtainable by the instantly claimed bonding method (col.19, lines 54-62). Kawakubo et al. do not appear to disclose a specific primer composition. Azechi discloses a primer composition comprising a silane coupling agent wherein the silane coupling agent has at least one functional group selected from the group as instantly claimed (col.8, line 9-col.9, line 32), wherein the primer composition comprises a polyvalent alkoxy silane and/or a condensation product thereof (col.2, line 53-col.8, line 8), wherein the primer composition comprises an organoaluminum compound and/or an organotitanium compound (col.17, lines 24-30), a hydrosilylation catalyst (col.17, lines 56-65), and an organic solvent (col.18, lines 42-53), on a substrate (col.19, lines 5-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the primer composition as taught by Azechi as the primer in the coating process of Kawakubo et al. because Azechi teaches that applying a primer layer increases adhesion to plastic substrates resulting in a higher quality product.

Regarding Claims 16 and 17, Kawakubo et al. disclose a curing agent comprising two or more silicon-bound hydrogen atoms per molecule, and wherein the curing agent

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is a polyorganohydrogen polysiloxane containing two or more hydrosilyl groups per molecule (col.7, line 21-col.9, line 15).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan *CMK*

August 6, 2002



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700